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EXAMINER

PASCUA, JES F

ART UNIT

PAPER NUMBER

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35

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 35

Application Number: 09/978,215
Filing Date: October 15, 2001
Appellant(s): RODRIGUEZ, LUIS J.

MAILED

AUG 26 2003

GROUP 3700

Luis J. Rodriguez
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 7, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 45-70.

Claims 1-44 have been canceled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on October 17, 2002 has not been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

Claims 45-49 and 60-70 are rejected under 35 U.S.C. 112, first paragraph.

The rejection of claims 45-53 under 35 U.S.C. 112, second paragraph is presently withdrawn.

Claim 60 is rejected under 35 U.S.C. 112, second paragraph.

Claims 45-47, 62-64 and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Schieman.

Claims 45-47, 49-51, 53-55, 57, 58, 62-64, 66 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wilbur or Schieman.

Claims 48, 52, 56, 60 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wilbur or Schieman, as applied to claims 45, 50, 54, 59 and 62, and further in view of Stenner.

Claims 59 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wilbur or Schieman.

(7) Grouping of Claims

The rejection of claims 45-70 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

A substantially correct copy of appealed claims 45-70 appears on page 31 of the Appendix to the appellant's brief. The minor errors are as follows: Claim 60 has not been canceled and is presently copied below for the benefit of the Board.

60) The self sealing letter sheet of claim **59)**, wherein said self sealing letter sheet is one of a continuous assembly of detachable letter sheets.

(9) Prior Art of Record

2,367,440	SCHIEMAN	01-1945
2,384,223	WILBUR	09-1945
3,027,067	JOHNSON	03-1962
5,607,100	STENNER	03-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 45-49 and 60-70 are rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in prior Office Action, Paper No. 12.

The rejection of claims 45-53 under 35 U.S.C. 112, second paragraph is presently withdrawn. This rejection is set forth in prior Office Action, Paper No. 12.

Claim 60 is rejected under 35 U.S.C. 112, second paragraph.

Claims 45-47, 62-64 and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Schieman. This rejection is set forth in prior Office Action, Paper No. 12.

Claims 45-47, 49-51, 53-55, 57, 58, 62-64, 66 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wilbur or Schieman. This rejection is set forth in prior Office Action, Paper No. 12.

Claims 48, 52, 56, 60 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wilbur or Schieman, as applied to claims 45, 50, 54, 59 and 62, and further in view of Stenner. This rejection is set forth in prior Office Action, Paper No. 12.

Claims 59 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wilbur or Schieman. This rejection is set forth in prior Office Action, Paper No. 12.

(11) Response to Argument

Regarding appellant's arguments concerning the rejection of claims 45-49 under 35 USC 112, first paragraph, the remark that "claims 45 and its dependent claims 46-49 fully comply with 35 USC 112" is opinion.

Appellant's argument fail to address the rejection that the phrase "at least one" as a modifier of "mono-sectional body" is drawn to new matter.

Appellant's argument regarding the rejection of claim 49 under 35 USC 112, first paragraph fail for the reason previously set forth since claim 49 includes the new matter of claim 45.

Appellant's arguments are silent with respect to the rejection of claim 60 including new matter.

Regarding appellant's arguments concerning the rejection of claims 68-70 under 35 USC 112, first paragraph, appellant remarks that the original specification supports the combination of a dry adhesive and a low tack adhesive. However, appealed claims 68-70 recite, "at least one layer of a repositionable adhesive and at least one layer of a dry adhesive". Neither appellant's original specification nor arguments explicitly state the "repositionable adhesive" to mean "low tack adhesive".

Appellant's arguments concerning the rejection of claims 45-53 under 35 USC 112, second paragraph are moot since the Examiner is no longer maintaining that rejection.

Appellant's arguments are silent with respect to the rejection of claim 60 being indefinite.

In response to appellant's arguments, that Schieman is not a "self sealing letter sheet" or a "self sealing form" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand

alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding appellant's argument that Schieman does not disclose a "mono-sectional body", the Examiner maintains that the body of Schieman is mono-sectional to the degree that the body is formed from a unitary sheet of material.

In response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., "**each flap** needs to be in contact with the body, and remain in a temporarily fastened condition until sealing is desired") are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to appellant's argument that Schieman and Wilbur are nonanalogous art with respect to Johnson, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Johnson is in the field of appellant's endeavor (letter sheets and forms having sealing flaps). Schieman and Wilbur are

reasonably pertinent to a particular problem with which appellant was concerned. One specific problem on page 2, lines 18-20, of appellant's original specification states,

"6) Some of these systems require adhesive coatings to be moistened to promote adhesion...incurring thereby in additional steps and costs."

Regarding appellant's argument that commercially producing the letter sheets of Johnson with the incorporated a tear string poses a serious problem, appellant is reminded the method of forming the device is not germane to the issue of patentability of the device itself.

In response to appellant's argument that the present invention is to be suitable for laser printers and other friction and heat generating machines, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Appellant's remark that, "the incorporation of interactive release and pressure sensitive adhesive is not compatible with Johnson's invention..." is opinion and fails to overcome the combination of the prior art as a whole. Furthermore, there is nothing in

Johnson that precludes "the incorporation of interactive release and pressure sensitive adhesive".

In response to appellant's argument that there is no motivation to combine the envelopes of Schieman or Wilbur with the letter sheet of Johnson in order to arrive at appellant's claimed invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the present case, Schieman and Wilbur each suggest that it is desirable to provide adhesive inhibitors on mailing assemblies having adhesive flaps in order to prevent premature adherence of the flaps.

Regarding appellant's affidavit of "long felt need", filed on May 20, 2002, appellant fails to show that the need has been a persistent one that was recognized by persons having ordinary skill in the art.

Appellant argues that, "Stenner is a multiple envelope with enclosures, which disqualifies it as a reference against a self sealing letter sheet. Thus, it is inconceivable that an envelope, and a reply sheet be combined with a piece of 'direct mail' with plurality of envelopes and enclosures because they all relate to different species."

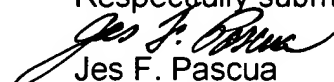
Appellant's argument is opinion. Furthermore, appellant's reiteration of the structure disclosed by Stenner does not refute the desirability of Stenner to provide a plurality of forms in series, separated by lines of perforations in order to mass produce forms.

Appellant's argument that "Johnson teaches away from the combination proposed by the Office" is not persuasive because Johnson was not applied in the rejections as a secondary, or teaching, reference, but instead as the primary reference.

Regarding appellant's numerous references to "amendment C", filed on October 17, 2002, it is brought to the attention of the Board that the disposition of amendment C and the numerous petitions subsequently filed thereafter have been summarized by the "Decision On Petition" in paper no. 33.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Jes F. Pascua
Primary Examiner
Art Unit 3727

JFP
August 20, 2003

Conferees
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